

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 10, 2006 (the "Office Action"). Claims 20-24 and 46-67 were previously cancelled, and claim 8 has been cancelled in this amendment. Claims 1-7 and 9-19, 25-45 and 68-78 remain for consideration, and independent claims 1, 15, 25, 34, 68 and 72 have been amended, as well as dependent claims 2-7, 9-13, 16-19 and 43. Claims 1-7, 9-19, 25-45 and 68-78 are believed to be allowable in light of the claim amendments and arguments presented below.

Amendments

The claims have been amended to further emphasize patentably distinguishing features of the invention. Plastic fences, plastic wraps around wood, and plastic components have been used in prior art fence systems in an effort to improve the durability of residential fences. However, these fences typically may degrade due to exposure to ultraviolet light, and are also much less aesthetically appealing because they do not have a natural look similar to wood. In addition, these fences typically require specialty made fasteners and brackets in order to secure the material to the fence, and oftentimes, due to the types of material used in the fence, conventional fastening

materials are not capable (or practical) for use. This is the case for the fiberglass/plastic mold fence panel disclosed in the Newberry reference cited by the Examiner, which requires the use of a complex mounting bracket(s)/support(s) to secure the plastic panel to the fence posts.

One aspect of Applicants' invention is to provide a fence system with superior components, but yet which is also easy to install. As such, Applicants' fence system contains materials made of fiber cement, which is superior to conventional fencing materials, but still retains the ability to employ conventional fasteners, such as for example, nails, screws and staples, to secure the individual members to the horizontal support, such fasteners passing through the front surface and the back surface of each individual member.

Independent claims 1, 15 and 34 have been amended to recite that each individual member in the fence system has an upper end, a lower end; a front surface, a back surface and a pair of sides adjoining the front surface and back surface. The claims have also been amended to recite that the fence system contains a plurality of individual fasteners for attaching the plurality of individual members to the mounting surface, wherein each

individual fastener passes through the front surface and the back surface of the individual member.

**Section 103 Rejections**

In the Office Action, the Examiner rejects Claims 1-19, 25-45, and 68-78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 3,801,072 to Newberry, Jr. ("Newberry") in view of U.S. Patent Application Publication 2001/0047741 to Gleeson et al ("Gleeson"). With respect to the rejection as to claim 8, claim 8 has been cancelled. As such, Applicants respectfully submit that the rejection as to this claim is moot.

Applicants respectfully submit that neither the Newberry or Gleeson references, taken individually or in combination, teaches or makes obvious, a fence system as presently recited in Applicants' claims. For example, neither Newberry or Gleeson, taken individually or in combination, teaches or makes obvious a fence system containing a mounting surface and a plurality of individual members attached to the mounting surface, wherein each individual member has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the plurality of individual members comprises fiber cement, as recited in Applicants' amended claim 1. In addition, Applicants

respectfully submit that neither Newberry or Gleeson, taken individually or in combination, teaches or makes obvious, a fence system containing a plurality of individual fasteners for attaching the plurality of individual members to the mounting surface, wherein each individual fastener passes through the front surface and the back surface of the individual member as recited in Applicants' amended claim 1.

Newberry discloses a fiberglass unitary fence panel that "simulates the appearance of a plurality of individual staves vertically arranged adjacent each other as they would appear in a finished fence" (see Newberry Col. 3, lines 61-64), but is not made up of individual components. See Newberry Col. 3, lines 45-49. Newberry's process involves preparing a fiberglass mold of an existing "model" fence which is any existing fence, so as to "**simulate the appearance** of virtually any conventional fence material." However, it should be noted, that Newberry does not teach the reproduction of an existing model fence, but rather only the simulation of the appearance of such existing fence. As expressly stated in Newberry, "although the model fence is fabricated from a plurality of individual components, **the fiberglass panel formed is a unitary panel.**" The junctions between the individual components [i.e., of the "model" fence],

therefore, should be relatively continuous. Newberry clarifies that the panel formed by the mold will not actually have "junctions" as are present in the model fence, but rather "the junction will then appear in the finished panel as a distinct grain line which has the physical appearance of the original junction." Col. 4, line 49-51.

In addition, positioned along the back of Newberry's fence panel - and permanently and rigidly bonded to the panel - are horizontal tubular supporting members or bars 12. 3, 36-38 and 4,2-3. No fastening member is inserted through the molded fence panel, but rather, the panel is attached to the fence post by horizontal tubular supporting members rigidly bonded to the panel. See generally, Newberry, FIGURE 4.

While Gleeson discloses a fiber cement building material having low density additives and cellulose fibers, Gleeson does not disclose or suggest a fiber cement material for use in a fence system as presently claimed that contains a mounting surface, and a plurality of individual members, wherein each individual member has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, wherein the plurality of individual members comprise fiber cement having fibers, and are made into a

desired shape for use in the fence system prior to curing of said fiber cement, wherein the plurality of individual members do not exhibit any substantial fraying of the fibers along the surfaces of the plurality of individual members after curing as recited in Applicants' amended Claim 1.

There is no suggestion or motivation to prompt one of ordinary skill to selectively and non-inventively combine elements from Newberry and Gleeson to arrive at Applicants' claims. As recited above, Newberry's process involves preparing a fiberglass mold of an existing "model" fence. There is no suggestion or motivation in Newberry to employ a plurality of individual members each having an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the plurality of individual members comprise fiber cement having fibers, and are made into a desired shape for use in the fence system prior to curing of said fiber cement, wherein the plurality of individual members do not exhibit any substantial fraying of the fibers along the surfaces of the plurality of individual members after curing as recited in Applicants' amended Claim 1. Applicants submit that there is no motivation or desire to employ individual "pickets" in Newberry, as Newberry's process involves

forming a unitary panel of pickets. In addition, formation of individual pickets would not allow the integral attachment of the horizontal mounting tubular bar as required for Newberry's fence panel to be operable. In addition, Newberry does not disclose or suggest forming such individual member into a desired shape prior to curing such that the individual member does not exhibit any substantial fraying of the fibers along the surfaces of the at least one individual member.

Although Gleeson discloses that fiber cements may be applicable to fencing applications, this would not be interpreted to include fences which have a partially decorative function by one of ordinary skill in the art. It is known in the art that fiber cement materials (received from the manufacturer in a cured condition) may be "cut" to form a desired shape, but that when cut, the side surfaces of the fiber cement material exposed to the cutting typically exhibit damage, which take the form of visible fraying of the fibers. Or in the case of fiber cements formed in lamination processes described in Gleeson, such as the Hatschek sheet process or hand lay-up, this damage may manifest as separation of the cement fiber layers. These types of damage detract from the appearance of the fiber cement product.

As such, even assuming that the Newberry's "model" fence comprised fiber cement (which as recited above, Applicants maintain that there is no motivation or suggestion to employ fiber cement), one of skill in the art would expect the resulting panel (produced in Newberry's mold) to reflect the appearance of the substantial fraying of fibers that would have existed in the theoretical fiber cement fence. As such, Applicants submit that even if Newberry were combined with Gleeson, there is no reasonable expectation of success in achieving Applicants' claims, for example, an individual fence member that does not exhibit any substantial fraying of the fibers along the surfaces of the at least one individual member after curing, because as shown below, one of skill in the art would assume that the resulting mold would exhibit the substantial fraying of fibers present in traditional fiber cement materials.

Finally, even if the references are combined, the combined references do not teach or suggest all of Applicants' claim limitations. For example, the references do not teach or suggest a fence system comprising a horizontal mounting surface, and a plurality of individual members attached to the mounting surface, wherein each individual member has an upper end, a

HARD1.072A  
Atty Dkt No. 129843-1082

*PATENT*

lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the plurality of individual members comprises fiber cement having fibers, and made into a desired shape for use in the fence system prior to curing of said fiber cement. Also, the references do not teach or suggest a fence system containing a plurality of individual fasteners for attaching the plurality of individual members to the mounting surface, wherein each individual fastener passes through the front surface and the back surface of the individual member as recited in Applicants' amended claims.

For these reasons, Applicants respectfully request that the Examiner withdraw the rejections under § 103.

CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance, and Applicants earnestly seek such allowance of Claims 1-19, 25-45, and 68-78. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' attorney at 214.999.4487. Applicants, through their attorney, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843.1082. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

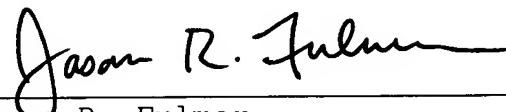
This is intended to be a complete response to the Office Action mailed February 10, 2006.

HARD1.072A  
Atty Dkt No. 129843-1082

PATENT

Please direct all correspondence to the practitioner listed  
below at Customer No. 60148.

Respectfully submitted,

  
\_\_\_\_\_  
Jason R. Fulmer  
Registration No. 46,715

Gardere Wynne Sewell LLP  
Thanksgiving Tower  
1601 Elm Street, Suite 3000  
Dallas, Texas 75201-4761  
Telephone: 214.999.4487  
Facsimile: 214.999.3487  
jfulmer@gardere.com

ATTORNEY FOR APPLICANTS  
May 10, 2006